

REMARKS/ARGUMENTS

Status of the Claims

Claims 1 through 32 are currently pending in this response. All of the claims have been rejected as obvious under 35 U.S.C. 103(a) as being unpatentable over Anderson et al. (U.S. Patent Application Publication Number 2001/0018739) in view of Dutta et al. (U.S. Patent Application Publication Number 2002/0152164).

In order to further distinguish the invention from Anderson, Applicants have amended each of the independent claims to refer specifically to the processing of *paper* checks. In light of the foregoing amendments, Applicants respectfully ask that the rejections be withdrawn.

Remarks

• Summary of the Claimed Invention

The claimed invention is directed to solving a problem that has had a long-felt need for a solution. For many years, financial institutions such as banks have made images of cancelled paper checks, deposit slips, and other financial documents that they process available, for a temporary period, available to be retrieved by their customers online. Unfortunately, customers are only able to retrieve these cancelled paper check images one at a time. Furthermore, these downloaded check images are neither indexed nor integrated with customer-side financial software packages.

This is extremely inefficient for the customer. Therefore, there has been a long-felt but unmet need for improved financial transaction systems that are capable of automatically incorporating check image data, reducing the burdens of manual entry of payee information, or both by supplying the information in usable digital form.

There is also a need for system and software tools for capturing, organizing, and perusing financial transaction information, including the check images. Financial institutions such as banks, credit unions, and saving and loan institutions are currently spending large amounts of money to store or scan and archive images of the billions of cancelled checks, deposit slips, and other financial documents that they process every year. Some of these institutions mail copies of cancelled checks to their customers at great expense. The check images can also be downloaded. To reduce those expenses, others make their customers' account information, including check and deposit slip images, available to their customers online. The account information has also been made available on CD-Roms.

The customers of these financial institutions, however, have no efficient way of making a permanent record and searchable archive of the cancelled check or deposit slip images. Instead, such customers are typically required to open each check image individually, one at a time, and print or locally save the check image. For high-transaction-volume customers, this is an

exceedingly time-consuming exercise. Needless to say, there is a substantial need for an efficient method of making a permanent and searchable database of a customer's check and deposit slip images.

- ***Anderson does not provide software or methods for generating a downloadable archive or index of images of cleared paper checks, or of complementary software for downloading them.***

Anderson's invention is directed to replacing many similarly formatted formal documents – such as checks, mortgage loan applications, contracts, and medical records – with SGML-compliant electronic instruments. For example, Anderson proposes “an electronic payment alternative” [0078] to replace conventional checks. Namely, Anderson proposes a new electronic instrument, based on Financial Services Markup Language (FSML) [0147], that would have “a digital representation of a verifiable certificate by the institution of the authenticity of the account, the payer, and the public key of the payer....” [0060]; “(a) payment instructions, (b) the identity of the payer, (c) the identity of the payee, and (d) the identity of the funds-holding institution.” [0061]; and “digital representations of [one or more] verifiable signature[s]” [0062, 0069, 185]. This new “all-electronics payments and deposit gathering instrument” could be used with “a variety of devices, such as a personal computer, screen phone, ATM or payments accounting system.” [0077]. Although Anderson's new electronic instruments are designed to “comply with existing legal structures for paper checks” [0169] and be “accessed and manipulated with existing computer systems for demand deposit accounts” [170] and “in some respects mimic[] the paper check” [0173], Anderson's electronic instruments are new and different from conventional paper checks [0196] and does not solve the need customers have for better systems for collecting, indexing, and organizing processed conventional checks.

Anderson also proposes a new “electronic checkbook,” which Anderson defines as “an electronic card (e.g., a smart card) that is programmed to act as an electronic checkbook.” [0167]. This electronic checkbook would carry signature and private decryption keys and activation PINs [0167]. It would preferably be in the form of a “PCMCIA card” that would be inserted into computer workstations in order to complete some part of a financial transaction. [0180]. This PCMCIA card would “prefix[] each electronic check with its serial number” and “automatically increment[] the numbers of the electronic checks.” [0217]. The PCMCIA card would also use a secure hash algorithm to generate a hash function and bind it to each electronic check. [0218]. Anderson notes that with “standardization of the electronic checkbook interfaces and the API's to access electronic checkbook functions,” it is possible to integrate the electronic checks with “a variety of home and small business accounting ... software packages” so that, for example, “an electronic check [c]an be attached to electronic remittance information provided by a remote payee” so that when the payment is made, it is “automatically posted to both parties' accounting systems.” [0234].

Anderson's ambitious and revolutionary proposal to replace the current check system with new electronic funds payment instruments does not solve or meet the long-felt need of customers to process, index, and organize the cancelled check information related to their conventional paper checks.

- ***Anderson also does not disclose the elements of many of the dependent claims.***

Anderson does not teach and is not concerned with generating a downloadable single file archive of multiple checks (electronic or paper) together with the corresponding cleared check images (claim 16), or downloading these indexes or archives of multiple checks.

Moreover, paragraph 180 of Anderson discusses electronic checks, not paper check images. Paragraph 180 makes no mention of an “optical character recognition module operable to identify typed or written information in a cleared check image” (claims 13, 32). This paragraph also does not teach incorporating copies of “images” of cleared paper checks into a “downloadable index” (claims 2, 7-8). Neither this paragraph, nor any other paragraph in the description of the Anderson invention, discuss a “downloadable index” at all. Nor does Anderson, in paragraphs 237-238, or anywhere else, teach “a check data and image perusal software module ... operable to search the downloaded index according to check number and to generate a search result that displays an image of the check corresponding to a searched-for check number together with textual information stored in the index identifying the check image.”

- ***Dutta also fails to provide software or methods for generating a downloadable archive or index of images of cleared paper checks, or of complementary software for downloading them.***

Dutta is directed to a method and apparatus for performing check clearing processes on imaged checks. Like Anderson, Dutta is entirely unconcerned with generating a downloadable archive or index of images of cleared paper checks for bank customers, or with providing customers with complementary software to download the index together with images of the cleared checks.

- ***All of the limitations of the independent claims are not taught or suggested by the prior art***

It is well established that “[t]o establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” MPEP 2143.03. Here, the combination of Anderson and Dutta does not teach the following limitations found in independent claim 1:

- providing an index generating software program to a financial institution for use on a first computer;
- that generates a downloadable index of images of cleared paper checks;
- providing complementary software to a customer;
- that is operable to remotely download the downloadable index of images of cleared paper checks, together with the images of the cleared paper checks, and to display the images of the cleared paper checks.

The combination of Anderson and Dutta also does not teach the following limitations found in independent claim 6:

- providing a checking account customer of a financial institution with access over a network to images of paper checks that have cleared the customer's checking account;
- providing the customer with a financial transaction bookkeeping program that downloads and stores copies of the cleared paper checks images and presents images thereof through a checking account ledger;

The combination of Anderson and Dutta does not teach the following limitations found in independent claim 15:

- index generating software on a remote computer serving a financial institution that generates indexes of images of cleared paper checks maintained for the financial institution; and
- an index downloading software module residing on a customer's personal computer that is operable to remotely access and download the index together with the cleared paper check images.

The combination of Anderson and Dutta does not teach the following limitations found in independent claim 21:

- providing a financial institution software program that periodically generates digital archives of cleared paper check images for an account customer;
- providing an account customer with secure online access to the digital archives and enabling the customer to download and store the digital archives of cleared paper check images.

- ***The invention is non-obvious in light of KSR Int'l Co. v. Teleflex Inc.***

The claimed invention is patentable under the Supreme Court's recent decision in *KSR Int'l Co. v. Teleflex Inc.* The claimed invention here is not (as the claimed invention in *KSR* was) a "combination of familiar elements according to known methods" that "does no more than yield predictable results." There are no familiar prior art applications that provide the archive or index generating and downloading modules of claims 1, 15 and 21, or that are designed to integrate processed paper check images into a customer's financial transaction bookkeeping software program. The advances made by the claimed invention require real innovation and hard work, not easily-implemented off-the-shelf tools.

Conclusion

Applicants respectfully submit that the foregoing amendments and remarks distinguishing the invention from the cited prior art are sufficient to put the claims in a condition for allowance. Should the Examiner desire to sustain any rejections, the courtesy of a telephone conference between the Examiner, the Examiner's supervisor, and the undersigned attorney at (719) 689-0700 is respectfully requested in advance.

Appl. No. 10/824,792
Response dated Dec. 5, 2007
Reply to Office Action of Aug. 23, 2007

Believing that all things raised in the Examiner's August 31, 2007 Office Action have been addressed, the undersigned respectfully requests that the application be allowed and passed to issue.

Respectfully submitted,



Date: Dec. 5, 2007

Eric W. Cernyar
Registration No. 45,919
Phone: (719) 689-0700
eric@cernyar.com
Charles W. Hanor
Registration No. 27,132
Phone: (210) 829-2000
Fax: (210) 829-2001
patents@hanor.com

ATTORNEYS FOR APPLICANT